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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

112740-665

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Application Number

09/013,451

Filed

August 14, 2001

First Named Inventor

Detlef Stoll

Art Unit

2613

Examiner

Dalzid E. Singh

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record. 48,196
Registration number _____



Signature

Peter Zura

Typed or printed name

312-807-4208

Telephone number

attorney or agent acting under 37 CFR 1.34.

March 28, 2007

Registration number if acting under 37 CFR 1.34 _____

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Detlef Stoll
Appl. No.: 09/913,451
Conf. No.: 9828
Filed: August 14, 2001
Title: CONFIGURABLE ADD-DROP MULTIPLEXING DEVICE AND OPTICAL
WAVELENGTH DIVISION MULTIPLEX TRANSMISSION SYSTEM
Art Unit: 2613
Examiner: Dalzid E. Singh
Docket No.: 112740-665

MAIL STOP - AF
Director of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This request is submitted in response to the Final Office Action dated September 28, 2006. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

Remarks begin on page 2 of this paper.

REMARKS

Claims 16-31 remain in this application. Claims 16, 30 and 31 are the focus of this request. Favorable reconsideration is respectfully requested.

Claims 16, 17, 22, 30 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Wu et al.* (US Patent 6,545,783) in view of *Gerstel* (US Patent 6,721,508).

Claim 23 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Wu et al.* (US Patent 6,545,783) in view of *Gerstel* (US Patent 6,721,508), and further in view of *Gaudino* (“Remote Provisioning of a Reconfigurable WDM Multichannel Add/Drop Multiplexer”).

Claims 24, 25, 28 and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Wu et al.* (US Patent 6,545,783) in view of *Gerstel* (US Patent 6,721,508), in view of *Gaudino* (“Remote Provisioning of a Reconfigurable WDM Multichannel Add/Drop Multiplexer”), and further in view of *Liu et al.* (US Patent 6,208,443). Applicants submit these rejections are improper, and requests reversal by this Panel.

Applicants maintain that the cited art, alone or in combination, fails to teach a plurality of different exchangeable module types each of which connect to a respective channel group for connecting through and branching off channels; the exchangeable modules comprising at least two of a first, second, and a third module type as recited in claim 16 and similarly recited in claim 30 and 31.

Furthermore, the cited art fails to teach a combination filter which receives and combines reconfigured channel groups outputted from the plurality of different exchangeable modules depending on their type, wherein the combination filter forms an outgoing WDM signal as recited in the present claims.

Applicant notes that the Response to Arguments stated that the phrase “exchangeable modules” was being interpreted as “elements [that exchange] optical signals by adding, dropping and/or pass-through the optical signals” (page 10, Office Action) Not only does this interpretation ignore the disclosure in the specification, but it also ignores the express language of the claims. The presently claimed features address an add-drop multiplexing device with different exchangeable

modules. A WDM signal is divided into channel groups, and each of the channel groups are fed into an exchangeable module. By using exchangeable modules, one modular type may be exchanged with a different modular type to accommodate different requirements for the device. Thus, a user may easily upgrade an add-drop multiplexing device without having to replace the device altogether (see page 2, lines 7-24; page 4, line 11 – page 5, line 21 of the substitute specification).

The claims (e.g., claim 16) recite “a plurality of different exchangeable module types” (line 4), comprising “at least two of a first, a second, and a third module type ... and inserted” (lines 7-8), where a combination filter “receives and combines reconfigured channel groups ... depending on their type” (lines 18-20). The cited prior art does not teach or suggest these features, as the references do not teach module types that are “exchangeable” and “inserted” into the device, where the channel groups are “reconfigured ... depending on their type.” As is explained below, the prior art only shows one type of module that is not (1) exchangeable, (2) inserted, and (3) capable of reconfiguring the channel groups.

Wu discloses a EDM add-drop multiplexer system, wherein the system uses modules for add-drop channels, while passing other signals as express channels (FIG. 1; col. 5, lines 19-35). As explained above, *Wu* does not disclose an add-drop multiplexer with different exchangeable modules – only one module type (500) is used. The Office Action claims that elements 201, 501 and 202 are “exchangeable modules,” however it is unclear to the Applicant how this can be interpreted in this manner. Presumably, the Office Action abstractly interpreted the capabilities of adding, dropping and pass-through as a “types” of modules. However, *Wu* clearly shows that they are not exchangeable.

Elements 201-204 are optical filters/demultiplexers (col. 5, line 10), and elements 501-502 are add-drop switch arrays (col. 12, lines 46-47). Nowhere in *Wu* is it taught that there devices are “exchangeable” so that channel groups may be reconfigures according to their type. If the add/drop switch array (501) were exchanged in the place of the optical filter (201). the system would be rendered inoperable. Furthermore, under the disclosure of *Wu*, these devices are all of the same type (i.e., the remote configuration of channels to be connected-through and add/drop channels). Consequently, *Wu* fails to teach the aforementioned features of the present claims.

Gerstel fails to solve the deficiencies of *Wu*, discussed above. *Gerstel* teaches an optical line terminal (OLT), that is separate from the multiplexing/demultiplexing device (6). In the embodiment disclosed in col. 4, line 61 - col. 5, line 5, *Gerstel* teaches the use of two OLT's arranged in a back-to-back manner to operate as an add/drop multiplexer between multiple WDM systems, wherein the OLT's are set up as a node within the network (col. 5, lines 22-43; lines 57-65). However, *Gerstel* does not teach the OLT configuration as part of a configurable add-drop multiplexing device as required by the present claims, and also does not teach the use of a plurality of different exchangeable modules, each of which connect to a respective channel group for connecting through and branching off channels; the exchangeable modules comprising at least one of a first, second, and a third module type.

Furthermore, there is no teaching, suggestion or motivation to combine the *Gerstel* and *Wu* references in the manner suggested in the Office Action. *Gerstel* teaches a plurality of OLT's configured as a node within a WDM network, while *Wu* teaches the WDM add/drop multiplexing system itself. No person of ordinary skill in the art would rely on the OLT configuration of *Gerstel* to incorporate within the WDM system of *Wu*. Furthermore, it is not understood how such a combination could be made without materially impairing the operability of *Wu*.

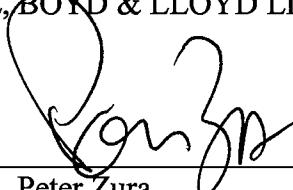
The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

For the reasons cited above, Applicants requests the rejections be reversed and respectfully submit that claims 16-31 are both novel and non-obvious over the art of record. Accordingly, Applicant respectfully requests that a timely Notice of Allowance be issued in this case. It is further noted that no fees are due in connection with this response at this time. If any fees are due in connection with this application as a whole, the office is hereby authorized to deduct said fees from Deposit Account No.: 02-1818. If such a deduction is made, please indicate the Attorney Docket Number (0112740-665) on the account statement.

Respectfully submitted,
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Dated: March 28, 2007